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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,890	11/20/2000	David N. S. Hon	460-001 Cont.IV	5003

1009 7590 03/26/2002

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EXAMINER

PATTEN, PATRICIA A

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 03/26/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/716,890

Applicant(s)
Hon et al.

Examiner
Patricia Patten

Art Unit
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

The numbering of the newly submitted claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 37-43 (as presented in the Preliminary Amendment filed 11/20/00) have been renumbered 22-28.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 22 and 23, drawn to a composition comprising an aqueous extract of oak bark , classified in class 424, subclass 775 for example.
- II. Claims 2-4 and 24-27, drawn to a composition comprising potassium, zinc, calcium, rubidium, sulfur and a carrier which is not identical to an aqueous extract of bark, classified in class 424 , subclass 610 for example.

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- III. Claims 5 - 9, drawn to a method for treating cancerous skin lesions with an aqueous extract of oak bark, classified in class 424 , subclass 614 for example.
- IV. Claims 10-13 and 17 drawn to a method for treating psoriasis by use of an aqueous extract of oak bark, classified in class 424, subclass 725 for example.
- V. Claims 14-16 , drawn to a method for treating impetigo with an aqueous extract of oak bark, classified in class 424, subclass 405 for example.
- VI. Claims 18-21, drawn to a method for treating gangrene with an aqueous extract of oak bark, classified in class 424, subclass 404 for example.
- VII. Claim 28 drawn to a method for enhancing wound healing with an aqueous extract of oak bark, classified in class 514, 783 for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, as evidenced by the claims themselves, the composition of Group II is not the same composition as the composition of Group I. An aqueous extract of bark contains many pharmaceutically active ingredients other than those listed in claim 2. For example, the extract contains chromium which has been known in the art to regulate blood glucose levels. Thus, because the compositions

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contain differing constituents, administration of each respective composition may result in different clinical outcomes.

Inventions I-II and III-V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case all of the instantly claimed methods (which are patentably distinct from each other) can be carried out with materially different products than those recited in the instant claims.

For example, plants such as myrrh and ginseng have been used in the art for treating gangrene. Compounds such as tetracyclotrile and benzopyrone have been known for treating cancerous lesions of the skin. Many plant extracts have been known to have a beneficial effect toward psoriasis such as corn and rose extracts. And further, there are a myriad of wound-healing compositions known in the art. Monoxodil for example is a very well-known composition which accelerates wound healing.

Thus, the search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group.

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Because these inventions are distinct for the reasons given above and the search required for each Group is not required for the others, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

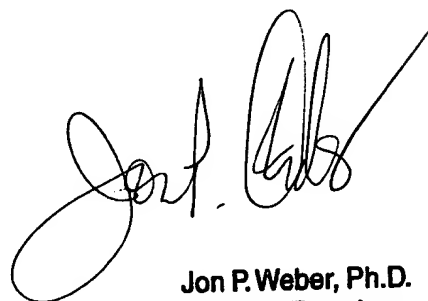
Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703)308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone

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number for the organization where this application or proceeding is assigned is (703)
308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read "Jon P. Weber", with a large, stylized flourish extending from the end of the signature.

Jon P. Weber, Ph.D.
Primary Examiner